<u>REMARKS</u>

Contemporaneously with the Request for Continued Examination (RCE), the Applicants hereby submit this Amendment and Request For Reconsideration in response to the Final Office Action mailed on 27 November 2006, and the Advisory Action of 22 March 2007, for the subject application.

Prior to this amendment, claims 1-19 and 24-25 were pending in the present application. In this amendment, claims 1, 7, and 13 have been amended and claims 4, 10, and 16 have been canceled. By this amendment, no new matter has been entered. The added limitations are fully supported in the present application as originally filed.

The Applicants acknowledge that an amendment submitted after a Final Office Action is not entitled for entry as a matter of right. In the present case, however, independent claims 1 and 7 have been amended merely to incorporate limitations of previous dependent claims 4 and 10, respectively (which have now been canceled); claim 13 has been amended merely to correct an inconsistency in antecedent basis. Independent claims 1 and 7 as amended now define subject matter having a similar scope to claims 13 and 19. Therefore, the Applicants respectfully request entry of the amendment as it raises no new issues, requires little effort on the office, and presents the claims in better form for appeal if necessary.

In the Final Office Action of 27 November 2006, the Examiner finally rejected all pending claims of the present application under 35 U.S.C. § 103(a) based on Johannesson et al. (WO 02/069661 A2) and Zhao (U.S. Patent Application Publication US2005/0059397 A1). In response, the Applicants respectfully disagree and submit that the claims allowable over the prior art for at least the following reasons.

1.   In order for claims to be properly rejected under 35 U.S.C. § 103(a), the prior art alone or in combination must teach or suggest each and every limitation of the claims. Furthermore, there must be some adequate suggestion or motivation to combine the teachings of the prior art.

To begin, Johannesson et al. fail to teach three steps as recited in context in the each one of the independent claims: (1) setting and running the periodic home network timer while operating with the communication network having the visiting MCC; (2) scanning to identify a plurality of communication networks in a coverage area within which the mobile station is operating (which is triggered by each expiration of a periodic home network timer); and (3) receiving, from the step of scanning, a plurality of MNC and MCC pairs associated with the plurality of communication networks.

The Examiner admits that Johannesson et al. do not teach or suggest the step of "receiving, from the step of scanning, a plurality of MNC and MCC pairs associated with the plurality of communication networks" as claimed in context. On the other hand, the Examiner argues that Johannesson et al. teach the claimed step of "scanning to identify a plurality of communication networks in a coverage area within which the mobile station is operating" by a passage in Johannesson et al. which states "scan and search for a better PLMN." However, a closer look at this passage in context reveals the following:

> Within present standards, the mobile station 10 would be required to scan and search for a better PLMN to provide service to the mobile station 10 upon the occurrence of certain criteria such as movement of the mobile station 10 from PLMN 4 to one of the other PLMNs or expiration of the HPLMN timer. In order to improve upon this system, rather than continuously or periodically scanning for a better PLMN 15 to serve the mobile station 10, the PLMN 15 currently serving the mobile station 10 may periodically transmit various information on neighboring PLMNs of the presently serving PLMN as illustrated in FIGURE 2. (Emphasis Added)

See page 4 at lines 4-12 of Johannesson et al. In addition, Johannesson et al. state on page 1 at lines 28-30 that:

> Also, under the present standard the mobile station is required to search for the HPLMN every time the HPLMN timer expires, <u>this can cause an unnecessary drain upon the battery power</u> of the mobile station. (Emphasis Added)

Further, on page 6 at lines 4-12 of Johannesson et al., it is further stated that:

> Thus, <u>rather than periodically scanning for new PLMN based upon the expiration of an HPLMN timer, the scanning will only take place when a better PLMN is determined to be available by logic 32</u>. This conserves a battery power of mobile station 10 since <u>no unnecessary scanning will be done</u>. PLMN reselection will also be done as soon as a better PLMN appears, since the <u>election of a new PLMN will not have to wait upon the expiration of the HPLMN timer</u> which may be anywhere from 6 minutes to 1,536 minutes. Thus, more efficient use of available PLMNs by the mobile station is provided. (Emphasis Added)

Therefore, it is apparent that Johannesson et al. do not teach or suggest the use of periodic time-triggered "scanning" step in the technique <u>as recited in context</u> in the independent claims. In fact, it says <u>just the opposite</u>. It is further apparent that Johannesson et al. do not teach or suggest the step of "setting and running a periodic home network timer while operating with the communication network having the visiting MCC" in the technique <u>as recited in context</u> in the independent claims.

In contrast, in accordance with the present invention, the claimed step of scanning is performed "after each expiration of a periodic home network timer" which is "set and run" ... "while operating with the communication network having the visiting MCC."

The Examiner makes reference to page 1 of Johannesson et al. for the purported teaching of the periodic home network timer utilized in the method. As illustrated above, however, the teaching of the HPLMN timer on page 1 is <u>not</u> utilized in the described technique of Johannesson et al. The Examiner further argues that Johannesson et al teaches the periodic home network timer on page 6 at lines 27-29, which states that "[t]he search could be initiated by a timer (not shown) responsive to a match between the provided MCC and an MCC of a preferred PLMN." However, this "timer" mentioned in Johannesson et al. is <u>not</u> a periodic home network timer or HPLMN timer. It is <u>not even</u>

a periodic timer, as this timer is triggered "responsive to a match between the provided MCC and an MCC of a preferred PLMN."

As apparent, there is no adequate suggestion or motivation to combine the teachings of the prior art. In the Final Office Action, the Examiner attempts to provide a suggestion or motivation by stating that (for example):

> It would have been obvious to one of the ordinary skills in the art at the time of invention to modify the system of Johannesson by incorporating the teachings of Zhao and consequently providing receiving, from the step of scanning, a plurality of mobile network code (MNC) and MCC pairs associated with the plurality of communication networks, motivation being for the purpose of allowing the selection process to compare the list of MNC and MCC pairs and accurately identify the home MCC network. (see e.g. page 4 of the Final Office Action).

In response, the Applicants submit that the above argument fails to provide an adequate suggestion or motivation to combine the prior art teachings, given the rest of the teachings in Johannesson et al.

There is no adequate suggestion or motivation for modifying the technique of Johannesson et al. to include use of a "periodic home network timer," the "scanning" step, and the "receiving" step as claimed. The prior art must be considered as a whole. Proper consideration must take into account any teachings that *teach away* from the suggested modification of the primary reference. Further, to change the technique of Johannesson et al. in the manner suggested by the Examiner would be to defeat the primary intent and purpose of Johannesson et al's technique. This is clearly apparent from the statements in Johannesson et al., in an of themselves.

In the Advisory Action, the Examiner fails to address these arguments regarding such teaching away and changing the primary intent and purpose of the primary reference. Again, Johannesson et al. state on page 1 at lines 28-30 that:

> Also, under the present standard the mobile station is required to search for the HPLMN every time the HPLMN timer expires, this can cause an unnecessary drain upon the battery power of the mobile station. (Emphasis Added)

11

Further, on page 6 at lines 4-12 of Johannesson et al., it is further stated that:

> Thus, rather than periodically scanning for new PLMN based upon the expiration of an HPLMN timer, the scanning will only take place when a better PLMN is determined to be available by logic 32. This conserves a battery power of mobile station 10 since no unnecessary scanning will be done. PLMN reselection will also be done as soon as a better PLMN appears, since the election of a new PLMN will not have to wait upon the expiration of the HPLMN timer which may be anywhere from 6 minutes to 1,536 minutes. Thus, more efficient use of available PLMNs by the mobile station is provided. (Emphasis Added)

As apparent, the Examiner's desire to alter the teachings of Johannesson et al. is improper under 35 U.S.C. § 103(a).

Thus, the prior art fails to teach or suggest each and every limitation in the claimed steps as received, and there is no adequate suggestion or motivation to modify the teachings of Johannesson et al. as the Examiner intends. Therefore, the Applicants respectfully request the Examiner to withdraw the Section 103 rejections, and allow the claims as amended.

2.   The Applicant further submits that US2005/0059397A1 does not qualify as prior art for any obviousness rejection under 35 U.S.C. § 103(a). Under 35 U.S.C. § 103(c), such prior art shall not preclude patentability where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In the present case, the subject matter and the claimed invention were owned by the same person or subject to an obligation of assignment to the same person at the time the claimed invention was made. The subject matter of the present application was assigned from all of the inventors to Research In Motion Limited in mid-April 2004. At the time of filing of the present application on 27 February 2004, the patent application was subject to such assignment. See the attached "Patent Assignment Abstract of Title" obtained through an assignment recordation search for U.S. Patent Application

Publication US2005/0107082 (Enclosure #1). In addition, U.S. Patent Application Publication US2005/0059397 was assigned to Research In Motion Limited at the time the claimed invention was made. See the attached "Patent Assignment Abstract of Title" obtained through an assignment recordation search for US2005/0059397 from the USPTO's website (Enclosure #2). As apparent, the date of such patent application assignment is 21 October 2003 which continued through the time of the claimed invention.

Based on the above, the Applicants respectfully submit that the claims as amended are allowable over the prior art of record and the application is now in a condition suitable for allowance.

Thank you. Please feel free to contact the undersigned if it would expedite prosecution of the application.

Respectfully Submitted,

/John J. Oskorep/

Date: 19 April 2007

JOHN J. OSKOREP
Reg. No. 41,234

JOHN J. OSKOREP, ESQ. LLC
ONE MAGNIFICENT MILE CENTER
980 N. MICHIGAN AVENUE, SUITE 1400
CHICAGO, ILLINOIS 60611 USA

Telephone: (312) 222-1860
Fax: (312) 475-1850